

REMARKS1. The claims.

Claims 2-9 have been cancelled. Upon entry of the amendment, claim 1 will be pending.

2. The amendments.

The specification has been amended to incorporate a reference to the priority document. This priority claim was made in Applicants' declaration.

Claims 2-9 have been cancelled as drawn to non-elected subject matter. Applicants reserve the right to prosecute claims 2-9 in divisional patent applications.

3. Rejections under 35 USC 102(b)

Claim 1 is rejected under 35 USC 102(b) as being anticipated by Suzuki et al., US patent 5,814,569 ("Suzuki") and Sabee, US patent 4,910,064 ("Sabee"). Applicants respectfully traverse for the reasons set forth below.

Suzuki. The Examiner states that Suzuki discloses a method for forming an elastic non-woven fabric by accumulating spun fibers on a belt, heating to form heat-bonded areas, and winding the resulting fleece on a roll in a continuous process, and asserts that this anticipates the present invention. However, Suzuki uses a non-elastomeric fiber (polyester with polyolefin sheath), and the elasticity of the Suzuki product is due to the conformation of the fabric's filaments, whereas the elasticity of the present invention's fabric is due to the fact that an elastomeric filament is used. Suzuki notes the distinction between such products at column 1, lines 18-22. The "elastomeric" limitation of the instant claims, which applies to the fiber, is thus not anticipated by Suzuki.

The claimed invention is also characterized by the limitation that the tension required to unroll the fabric is "0.25g/cm/basis weight or less", a limitation not disclosed by Suzuki. The Examiner contends that this limitation is a "process limitation" which cannot impart patentability to the product, citing *In re Stephens*, 145 USPQ 656 (CCPA 1965). However, "the question in such a case is always whether the product so formed does otherwise patentably distinguish over

the prior art." *In re Lurie*, 171 USPQ 758, 759 (CCPA 1971). As noted above, the product of the present invention is distinguished from Suzuki by the limitation to elastomeric fibers.

Furthermore, Applicants respectfully disagree with the Examiner's characterization of the limitation on unrolling tension as a "process" limitation. The Examiner appears to be asserting that the limitation on the unrolling tension should be regarded as a limitation to a process for unrolling the fabric. Applicants respectfully point out that *Stephens* attempted to distinguish the claimed product from the prior art by a limitation in the method of manufacture. That is not the case in the instant claims, where the unrolling tension is a physical property of the roll itself. It is the amount of tension that will suffice to unroll the fabric from the roll, after it has been manufactured by the process of the invention. For this reason, Applicants respectfully submit that *Stephens* is inapposite.

In summary, Applicants respectfully submit that the claimed fabric roll is not anticipated by Suzuki, in that at least two limitations (the elastomer filaments and the maximum unrolling tension) are not disclosed or even suggested by Suzuki. Reconsideration and withdrawal of the rejection under 35 USC 102(b) in view of Suzuki is respectfully requested.

Sabee. The Examiner states that Sabee discloses a non-woven web of melt-blown fibers, which are bonded to a parallel array of continuous fibers, cross-lapped with a second fabric layer, and ultimately processed into a roll of non-woven fabric (element 53 in Fig. 1 of Sabee appears to be the finished fabric roll). Applicants point out that claim 1 of the present application specifies

"... piling and bonding thermoplastic elastomer filaments into a sheet of nonwoven fabric, and *winding the nonwoven fabric thus formed* around a tube thereby forming a nonwoven fabric roll ..."

The claimed process thus involves piling and bonding filaments, followed *directly* by winding into a roll without intervening alteration of the fabric thus formed. This direct formation of a roll of non-woven fabric, from filaments that have merely been piled and bonded, is not disclosed by Sabee. Furthermore, the claim limitation that the tension required to unroll the claimed fabric roll is "0.25g/cm/basis weight or less" is not disclosed by Sabee. For these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 USC 102(b) in view of Sabee.

CONCLUSION

In view of the foregoing remarks, Applicants submit that the claims are in condition for allowance, and passage to issue is respectfully requested. The Examiner is invited to call Applicants' undersigned agent if it would expedite the prosecution of the application.

Respectfully Submitted,

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